

PATENT
W&B Ref. No. : INF 2268-US
Atty. Dkt. No. INFN/WB0072

REMARKS

This is intended as a full and complete response to the Final Office Action dated March 9, 2007, having a shortened statutory period for response set to expire on June 9, 2007. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-30 are pending in the application. Claims 1-30 remain pending following entry of this response. Claims 1 and 2 have been amended. New claims 31-32 have been added to recite aspects of the invention. Claims 31 and 32 are equivalent to previously presented claims 6 and 4, respectively, rewritten in independent form. Applicants submit that the amendments and new claims do not introduce new matter.

Allowable Subject Matter

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 6 has been rewritten in independent form, as new claim 31, including all of the limitations of the base claim. Accordingly, Applicants submit that new claim 31 is allowable and respectfully request withdrawal of the objection.

Claim Rejections - 35 U.S.C. § 102

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by *Koshikawa* (U.S. Patent No. 5,428,299). Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by *Schnabel* (U.S. Patent No. 6,788,087). Applicants respectfully traverse these rejections.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as

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is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, neither of references teach each and every element of the claims. For example, with respect to claim 1, neither reference teaches an internal test circuit for testing the first circuit, a test terminal coupled to the internal test circuit in order to provide an activation signal activating the test circuit to perform a test function, and a switching device to selectively couple the test terminal to the internal voltage line after receiving the activation signal and during testing of the first circuit, as recited.

The Examiner states that *Koshikawa* discloses, in Figure 5, a first circuit [26 with 22] to be tested, the first circuit comprising an internal voltage line [Vint], a test circuit [23] for testing the first circuit, a test terminal [Pext] coupled to the test circuit in order to provide an activation signal activating the test circuit to perform a test function, and a switching device [24] to selectively couple the test terminal to the internal voltage line during testing of the test circuit [column 8 lines 55-68 and fig. 6]. Applicants respectfully submit, however, that *Koshikawa* fails to teach an internal test circuit, as recited in the claim.

Regarding *Schnabel*, Applicants respectfully submit that *Schnabel* fails to teach a switching device to selectively couple the test terminal to the internal voltage line after receiving the activation signal and during testing of the first circuit, as recited. The recited switching functionality after receiving an activation signal is not taught.

Accordingly, Applicants submit that claim 1 and its dependents are allowable and respectfully request withdrawal of this rejection.

Claim Rejections - 35 U.S.C. § 103

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Schnabel* as applied to claim 1 above, and further in view of *Horiguchi et al.* (U.S. Patent No. 5,347,492, hereinafter, "*Horiguchi*").

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The Examiner has rejected Applicant's dependent claim 4 for obviousness given the combination of *Schnabel* with other cited references.

However, the *Schnabel* reference may not be used as a reference to preclude patentability for obviousness pursuant to 35 U.S.C. § 103(c), which states:

Subject matter developed by another person, which qualifies as prior art only under [35 U.S.C. § 102(e)], shall not preclude patentability under this section [35 U.S.C. § 103] where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Schnabel constitutes prior art under only under 35 U.S.C. § 102(e) as it is "a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent." *Schnabel* published on May 8, 2003, and later issued on September 7, 2004 while the present application has a priority date of March 21, 2003. This reference, therefore, constitutes only § 102(e) prior art.

Because the subject matter of *Schnabel* and the subject matter claimed in the present invention were both owned by a common entity at the time the invention of the present application was made, *Schnabel* is disqualified as prior art for the purpose of rendering Applicant's claims unpatentable for obviousness. See MPEP § 706.02(I)(1)-(3). Specifically, the present application and *Schnabel* were, at the time the invention was made, owned by Infineon Technologies AG. Pursuant to MPEP 706.02(I)(2)(II), this assertion, which Applicants conspicuously state above, constitutes "sufficient evidence" by Applicants to disqualify *Schnabel* as prior art under 35 U.S.C. § 103. Hence, *Schnabel* may not be used as prior art to render Applicants' claims obvious.

Accordingly, Applicants submit claim 4, rewritten in independent form as new claim 32, is allowable and request withdrawal of this rejection.

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Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

If the Examiner believes any issues remain that prevent this application from going to issue, the Examiner is strongly encouraged to contact the undersigned attorney to discuss strategies for moving prosecution forward toward allowance.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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